

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

## **PRE-APPEAL BRIEF**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In accordance with the Pre-Appeal Brief Conference Pilot Program, the applicant submits this pre-appeal brief accompanying the Pre-Appeal Brief Request for Review. Please consider the following.

## **I. Status of the Claims**

Currently, claims 17, 22-27, and 55-58 are pending in this application. See *Applicant's Response dated November 6, 2006*, pp. 2-4. Claims 17, 22-27, and 55-58 stand rejected, all of which form the subject of this pre-appeal brief.

By way of background, this application was filed on November 19, 2003 with claims 1-54. In the first Office action dated July 21, 2005, the examiner identified six patentably distinct inventions and required restriction of this application to one of those inventions. The applicants filed a response on September 21, 2005, electing claims 17-27 for prosecution and adding claims 55-58.

The examiner issued a second Office action on December 19, 2005, rejecting claims 17-27 and 55-58 under 35 U.S.C. § 102(b) as anticipated by Dotta. The applicant filed a response on June 19, 2006, amending claim 17 to incorporate the limitations of dependent claims 18, 19, and 21, canceling claims 18-21 without prejudice, and traversing the examiner's rejections.

The examiner issued a final Office action on September 5, 2006, rejecting claims 17, 22-27, and 55-58 under 35 U.S.C. § 102(b) as anticipated by Dotta. The applicant filed a response on November 6, 2006, traversing the examiner's rejections without amendment.

The examiner issued an advisory action on December 6, 2006, maintaining the previous rejections. Accordingly, claims 17, 22-27, and 55-58 stand rejected forming the subject of this pre-appeal brief.

## **II. Issues on Appeal**

The issue on appeal is whether Dotta anticipates independent claim 17.

## **III. Argument**

The applicant respectfully submits that Dotta does not anticipate independent claim 17. Independent claim 17 is directed to a rotary press apparatus that includes, *inter alia*, a first ram and a second ram, a first cutting tool member coupled to the first ram, and a second cutting tool member coupled to the second ram, wherein the first and second cutting tool members comprise a cut-off blade and ram set. The applicant maintains his position that the art of record fails to teach or suggest first and second cutting tool members comprising a cut-off blade and ram set as recited in claim 17. Dotta teaches an upper die (1) having female tools or matrixes (3) and a lower die (2) having male tools or punches (4). However, Dotta does not teach that the upper and lower dies (1) and (2) have or can have a cut-off blade and ram set. Therefore, Dotta cannot anticipate independent claim 17 because Dotta does not teach each and every element recited in independent claim 17.

The examiner suggests that one of ordinary skill in the art would know the matrixes (3) and punches (4) taught by Dotta are capable of shearing off the ends of thin strips of material due to their widths, and that the cut-off blade and ram set recited in claim 17 describe the matrixes (3) and the punches (4). *See Final Office action dated August 5, 2006, pp. 2 and 3, ¶ 3 and Advisory Action dated December 6, 2006.* The applicant respectfully

submits that the examiner has adopted an improper and unfairly broad meaning for the language cut-off blade and ram set. *See Applicant's Response dated November 6, 2006*, p. 2, ¶3 through p. 3, ¶1.

Additionally, in the advisory action, the examiner suggests that one of ordinary skill in the art knows that if a workpiece is less wide than the diameter of one of the Dotta punches (4), then the workpiece is not only sheared by the adjacent edges of the punch and die, but is completely severed from the rest of the workpiece. *See Advisory Action dated December 6, 2006*. The examiner's reasoning amounts to taking official notice that one of ordinary skill in the art would know that the punch and die taught by Dotta constitute the cut-off blade and ram set recited in claim 17. The applicant respectfully submits that the examiner's suggestions are not "capable of instant and unquestionable demonstration as being well-known." *See MPEP § 2144.03(A)*. The Dotta punching device includes an array of the punches (4) arranged transversely of a band (N'). *See Dotta, 1:56-60*. The applicant respectfully submits that Dotta teaches feeding a band (N') of material that is wider than any one of the punches (4). Thus, none of the Dotta punches (4) would cut off one portion of the band (N') from another portion of the band (N') as would the cut-off blade recited in claim 17. The applicant respectfully submits that the examiner has not provided the evidence necessary to maintain the rejection based on his assumption that one of ordinary skill in the art would know that one of the Dotta punches (4) constitutes a cut-off blade. *See MPEP § 2144.03(B)*.

In addition, the Dotta punching device also includes a hydrostatic connection (a chamber 16) that permits the array of punches (4) across the band (N') to operate simultaneously on the band (N') to avoid excessive stress thereon and on the entire apparatus. *See Id., 2:58-62*. The principle of operation of the Dotta punching device is to make a plurality of punches simultaneously across the width of the band (N') of material using the plurality of punches (4). One of ordinary skill in the art would not use the Dotta punching device to shear material less wide than the diameter of a punch (4) as suggested by the examiner because doing so would not permit all of the punches (4) to operate simultaneously on a band of material, which is contrary to the principle of operation of the Dotta punching device.

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Accordingly, the applicant respectfully submits that Dotta does not anticipate independent claim 17 because Dotta does not teach or suggest a first ram and a second ram, a first cutting tool member coupled to the first ram, and a second cutting tool member coupled to the second ram, wherein the first and second cutting tool members comprise a cut-off blade and ram set. Further, one of ordinary skill in the art would not recognize that the punches described by Dotta act in a manner consistent with the meaning of a cut-off blade.

In view of the foregoing, the applicant respectfully submits that the examiner has improperly rejected claims 17, 22-27, and 55-58. Accordingly, the applicant respectfully requests withdrawal of the rejections and respectfully submits that independent claim 17 and all claims dependent thereon are in condition for allowance.

Respectfully submitted,

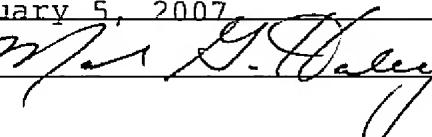
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Dated: **February 5, 2007**

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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional)  20015/10004	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]  on <u>February 5, 2007</u>  Signature 	Application Number  10/716,809	Filed  11/19/2003	
Typed or printed name  <u>Mark G. Hanley</u>	First Named Inventor  <u>Philip E. Bradbury</u>	Art Unit  3724	Examiner  <u>Issac N. Hamilton</u>

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

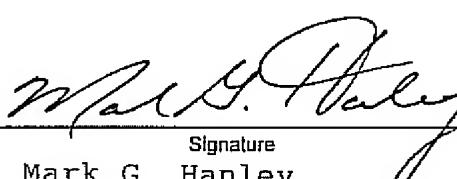
This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- applicant/inventor.
- assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)
- attorney or agent of record.  
Registration number 44,736
- attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_



Signature

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Typed or printed name

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Telephone number

February 5, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below.

<input type="checkbox"/> X	*Total of <u>1</u> forms are submitted.
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This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.